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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/573,778

03/28/2006

Hiroaki Masuyama

2006\_0448A

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EXAMINER

TO, BAOQUOC N

ART UNIT

PAPER NUMBER

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MAIL DATE

DELIVERY MODE

01/08/2009

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/573,778	<b>Applicant(s)</b> MASUYAMA ET AL.	
	<b>Examiner</b> BAOQUOC N. TO	<b>Art Unit</b> 2162	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 December 2007.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-33 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-33 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 August 2008 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \*    c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>03/28/2006 and 12/06/2007</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-33 are presented for examination.

***Priority***

2. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Information Disclosure Statement***

3. The information disclosure statement (IDS) submitted on 03/28/2006 and 12/06/2007. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly, the information disclosure statement is being considered by the examiner.

***Drawings***

4. Drawing filed on 03/28/2006 is accepted by examiner.

***Claim Rejections - 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. Claims 1-22 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claims 1-11 recites a similarity calculation device however the claim limitations appears to be program per se or software per se.

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Claims 12-22 recite similarity calculation program which are program per se or software per se. Software per se is not a series of steps or acts and thus is not a process. Software per se is not a physical article or object and as such is not a machine or manufacture. Software per se is not a combination of substances and therefore is not a composition of matter.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 1-33 recites abbreviation such as IPC symbols and other mathematical symbols which are not clear what the meaning of those symbol as claimed. Applicants are advised amend the claims to overcome the 112 rejection as set forth in this Office Action.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 1 and 23 are rejected under 35 U.S.C. 102(e) as being anticipated by Plante et al. (Pub. No. US. 2002/0161626 A1).

As to claim 1, Plante discloses a similarity calculation device, which calculates an index for judging technical similarity between a first technical document group and a second technical document group, each comprising patent documents, technical reports, or other technical documents, characterized in comprising:

technical document group input means for inputting the first technical document group and the second technical document group for comparison (first document set and second documents set) (paragraph 0045);

technical information input means for inputting technical information such as keywords or IPC symbols (key concepts) (paragraph 0045);

cluster analysis means for retrieving technical documents containing the input technical information from technical documents contained in the first technical document group and the second technical document group, and for clustering the retrieved technical documents by each technical information (intersection list of concepts between two different groups of documents) (paragraph 0045);

similarity calculation means for calculating, as the similarity, the ratio of the number of intermixed clusters containing technical documents of both the first technical document group and the second technical document group, to the total number of clusters obtained as a result of the cluster analysis (during the indexing documents, the linguistic search engine an algorithm to find key concepts and stores them in a special

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zone of the indexed base. intersections in the list of concepts are taken into account when calculating the similarity between two more documents) (paragraph 0045); and output means for outputting the calculated similarity to recording means, to display means, or to communication means (stored) (paragraph 0029)

Claim 23 is rejected under the same reason as to claim 1.

***Allowable Subject Matter***

8. Claims 2-21 and 24-33 are allowed when the 101 rejection and the 112 rejection are overcome.

The following is an examiner's statement of reasons for allowance:.

As to claims 2-21 and 24-33, Plante et al. (Pub. No. US 2002/0161626) discloses during the indexing documents, the linguistic search engine an algorithm to find key concepts and stores them in a special zone of the indexed base. intersections in the list of concepts are taken into account when calculating the similarity between two more documents. Plante, alone or in combination, either teach or suggest "similarity calculation means for calculating the total number of clusters obtained as a result of the cluster analysis and the number of intermixed clusters containing technical documents of both the first technical document group and the second technical document group, as well as for calculating the sum, over all intermixed clusters, of the product of a first correction value which takes a value according to the number of technical documents contained in each intermixed cluster and a second correction value which takes a value according to the state of mixing of technical documents of the first technical document

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group and the technical documents of the second technical document group in each intermixed cluster, and dividing the sum by the calculated total number of clusters to calculate the similarity; and, output means for outputting the calculated similarity to recording means, to display means, or to communication means."

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Baoquoc N. To whose telephone number is at 571-272-4041, or unofficial fax number for the purpose of discussion (571) 273-4041 or via e-mail BaoquocN.To@uspto.gov. The examiner can normally be reached on Monday-Friday: 8:00 AM – 4:30 PM, EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Breene can be reached at 571-272-4107.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231.

The fax numbers for the organization where this application or proceeding is assigned are as follow:

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(571) 273-8300 [Official Communication]

/Baoquoc N To/

Primary Examiner, Art Unit 2162

August 17<sup>th</sup>, 2008